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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,817	02/27/2004	John G. Babish	068911-0074	5656
7590 04/03/2008				
Cathryn Campbell McDERMOTT, WILL & EMERY Sic. 700 4370 La Jolla Village Drive San Diego, CA 92122				
EXAMINER				
CARTER, KINDRA D				
ART UNIT		PAPER NUMBER		
1617				
MAIL DATE		DELIVERY MODE		
04/03/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/789,817

Applicant(s)

BABISH ET AL.

Examiner

KENDRA D. CARTER

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 16-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date 6/24/05

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-15 with the species election of tetra-hydroisovalpha acids in the reply filed on December 18, 2008 is acknowledged. The traversal is on the ground(s) that a thorough search of the claims of either group will likely reveal art relevant to the examination of the other groups. This is not found persuasive because reasons given the previous office action. Particularly, the all of the components of Group I are not required in Group II. In regards to the method claims and the compositions of Group I or II, the composition of Group I can be used as a mild stimulant instead of reducing inflammation. Thus, claims 16-32 are withdrawn because they are directed towards non-selected Groups.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramirez (US 2002/0102345 A1) in view of Chappel et al. (Food and chemical Toxicology, 1998, vol. 36, pp. 915-922).

Ramirez teaches a beverage composition (i.e. oral and inherently possess a pharmaceutically acceptable carrier; addresses claims 14 and 15) comprising beer (see page 2, paragraph 29, line 3 and claim 1) and caffeine (see page 6, paragraphs 85-91 and claim 13; addresses claim 1, 7 and 9). Once the base composition is provided, special ingredients may then be incorporated into the liquid in such quantities and relative proportions that help enhance the body's alertness and energy sensation (see page 6, paragraph 82).

Ramierz does not teach tetra-hydroisoalpha acid either derived or not derived from hops as disclosed in claims 1-6, nor the amounts of the compound nor ratio to the methylxanthine as disclosed in claims 8-13.

Chappel et al. teaches that during the storage of hops, deterioration may occur with losses in bittering value, thus tetrahydroisohumulones are manufactured from alpha acids, such as those elected by the applicant, that are more stable and provide more efficient bittering agent that can be added to beer late in the brewing process (see page 915, column 2, first full paragraph in its entirety).

To one of ordinary skill in the art at the time of the invention would have found it obvious and motivated to combine the composition of Ramierz and tetra-hydroisoalpa acids as those disclosed in claims 1-6 because Chappel et al. teaches that these compounds are added to the brewing process of beer to provide a more stable and efficient bittering agent. Thus, in the brewing of the Ramierz beer, one skilled in the art would be motivated to add a more stable and efficient bittering agent in order to overcome the problem of the beer not having a true taste of the bitterness in beer.

To one of ordinary skill in the art at the time of the invention would have found it obvious and motivated to combine the composition of Ramierz in view of Chappel et al. and the amounts of the tetra-hydroisoalpa acid and methylxanthine as well as the ratio between the two compounds as disclosed in claims 8-13 because one skilled in the art would be able to adjust the amounts of these compounds in order to provide the desired effect of bitterness (tetra-hydroalpa acid) and energy boost (methylxanthine; caffeine). Ramiez teaches that once the base composition is provided, special ingredients may then be incorporated into the liquid in such quantities and relative proportions that help enhance the body's alertness and energy sensation (see page 6, paragraph 82).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENDRA D. CARTER whose telephone number is (571)272-9034. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. D. C./
Examiner, Art Unit 1617

/SREENI PADMANABHAN/
Supervisory Patent Examiner, Art Unit 1617

